The above amendments have been made in an effort to more clearly define the present invention. The amendments are editorial in nature and do not add any new matter to the claims.

The new Figure 4 finds literal antecedent basis in the original specification and figures, as seen for example in Figure 1, elements 108, 109, 110, 111, 112 and 113; and the written text of the specification on pages 8-16. The description added to the specification on page 20 may also be found on these same pages.

Antecedent basis for new claims 22-26 may also be found on these same portions of the specification.

STATEMENT OF THE OBJECTIONS AND REJECTIONS

Objection to the Drawings

1) Applicants are preparing drawings to correct the asserted deficiencies raised under 37 C.F.R. 1.83(a) without the introduction of any new matter. These draft figures will be presented shortly after the filing of this amendment.

2) – 4) The Schematics of Figure 2 will be reconsidered or deleted. The written disclosure in the specification fully enables practice of the present invention as will be described more fully with regard to a response to issues raised under 35 U.S.C. 112, first paragraph. Applicants are preparing drawings to correct the asserted deficiencies raised under 37 C.F.R. 1.81(b) without the introduction of any new matter. These draft figures will be presented shortly after the filing of this amendment.

Objection to the Abstract

Applicant has submitted a new abstract to overcome this objection. The new Abstract conforms to practice as described in the Objection.

Objection to the Specification and Rejection of Claims Under 35 U.S.C. 112, First and Second Paragraphs

1) The objection asserts that the specification "describes the system in generic terms that would apply to any effort to engineer such a system. Hence a great amount of experimentation would be required to recreate the apparatus."

2) The specification describes several embodiments, but does not clearly define a single best mode of the invention.

3) The specification fails to define the "universal" quality of the disclosed invention.

Claims Rejections Under 35 U.S.C. 112, First Paragraph

Claim 18 is rejected under 35 U.S.C. 112, first paragraph as lacking enablement. It is asserted that the I/O adapter is insufficiently described to enable its use without undue experimentation. It is also asserted that Applicant must provide greater detail as to the best mode application of the invention. It is also asserted that Applicant must clarify what is unique about the I/O component in comparison with the known I/O interfaces.

Rejections Under 35 U.S.C. 103(a)

Claims 1-21 have been rejected under 35 U.S.C. 103(a) as unpatentable over Acres (U.S. Patent No. 5,752,882) in view of Arcade Machine Retrofit (10/20/1996, www.cygnus.uwa.edu.aujaycole/jaw/arcade.htlm, hereinafter referred to as "Arcade").

RESPONSE TO THE OBJECTIONS

Objection to the Drawings

1) Applicants are preparing drawings to correct the asserted deficiencies raised under 37 C.F.R. 1.83(a) without the introduction of any new matter. These draft figures will be presented shortly after the filing of this amendment. The figures will be generic figures, as the pin conformation will depend upon the specific format of device into which the I/O adapter pin section will be installed. The installation may be effected with absolutely no undue experimentation. When having selected a specific format apparatus to be fitted with the novel system of the invention, the pin system from the original installation may be cut from the connecting wiring and rewired to the universal adapter hardware. It is more desirable to provide a duplicate pin configuration, but this again does not involve undue experimentation, but rather mere physical duplication. The I/O connector pin attachment is therefore merely a replication of the pin system and is readily understood and readily enabled to one of ordinary skill in the art.

2) – 4) The Schematics of Figure 2 will be reconsidered or deleted. The written disclosure in the specification fully enables practice of the present invention regard to the requirements of 35 U.S.C. 112, first paragraph. To appreciate how easily the present invention may be practiced, **once the conception of the invention has been made**, as was originally done by Applicant, the underlying invention will be described with reference to the specification.

When new games have been developed within the gaming industry, it has been necessary to develop a customized peripheral interface to support the game (Page 6, lines 25-27). The universal game controller of the present invention is a standard PC-type unit that provides all game functions necessary to **implement** a wide variety of games by loading various program code on the universal controller and then separately providing unique game information (e.g., from a separate gaming application-specific kernel) (see page 8, line 19 through page 9, line 4 of the specification). What is intended to be included in the term game functions includes button controls, coin acceptors, touch screen coordinates, credit managers, currency acceptors, operating system, security devices, game operating code and the like (Page 11, lines 14-22; page 15, line 23 through page 16, line 7). Additional game functions could be a store of images (e.g., cards or roulette wheel/symbols; see page 20, lines 1-4). These are separately provided with the I/O system as pinning-hardware/software in the PC-type system with a motherboard (Page 12, line 18, through page 19, line 8). The harness is fitted to the unique structure of the gaming device and the motherboard is connected to or integral with the harness/pin system (page 13, lines 5-8).

This type of system is quite distinct from conventional implementation of casino gaming systems where the entire system and program is originally installed with both game peripherals and game rules on the same board, so that replacement of a game in a given machines requires the complete replacement of both peripheral controls. The game rules also must be uniquely and completely reconstructed and replaced. In the system claimed in the enabled practice of the invention, the invention provides a distinct set of a) pinning connections and game peripherals and b) game rules/controls. Once these distinct sets are provided, the old game rules from the original video gaming system may be connected through the new pinning/peripheral system or a new set of games rules using the inventively provided pinning system/game peripherals previously installed. In this manner, game designers may need to develop only the rules of the

game, and the system peripherals are already available in the apparatus. This dramatically reduces game development time. (e.g., page 15, lines 2-7)

It must be pointed out at this time that the actual implementation of the invention uses known equipment, known software, known hardware, and known connectors. It is the design and distinct separation of functions that comprises the inventive step of the presently claimed invention. As the concept of providing the claimed configuration is clearly described in the specification, and as all of the component parts are within the conventional skill of the artisan to manufacture, the specification is *prima facie* enabling.

Applicants are preparing drawings to correct the asserted deficiencies raised under 37 C.F.R. 1.81(b) without the introduction of any new matter. These draft figures will be presented shortly after the filing of this amendment.

Objection to the Abstract

Applicant has submitted a new abstract to overcome this objection. The new Abstract conforms to practice as described in the Objection.

Objection to the Specification and Rejection of Claims Under 35 U.S.C. 112, First and Second Paragraphs

The objection asserts that the specification "describes the system in generic terms that would apply to any effort to engineer such a system. Hence a great amount of experimentation would be required to recreate the apparatus." The legal conclusion made in this objection is in error.

As Applicant has stated above, the individual components used in the practice of the present invention (without their content, with respect to the separate compilation of game peripherals) are components that can be described with enabling specificity by general terms known to those skilled in the art. The use of only general terms such as ports, computers, I/O interfaces, and the like, does not render the claims indefinite, and certainly does not require any experimentation in the association of the components in the manner specifically recited in the claims. Anyone of ordinary skill in the art would be able to assemble the general components in the manner recited, with their claimed content, without any undue experimentation. Based on

the teachings of the specification, the assembly of the components would be within the most routine skills of the ordinarily skilled electronic or programming engineer in the video gaming art. The fact that general components are described in a different arrangement of elements reduces the level of teaching that must be provided in the specification because the skill needed to connect those known general elements is clearly within the most routine skills of the artisan in the video gaming technologies field. This objection is clearly in error and must be withdrawn.

Applicant questions whether the rejection even meets minimum legal requirements (e.g., see *In re Strahilevitz*, Fed. Cir. 1982, 212 U.S.P.Q. 561) for establishing a *prima facie* case of failing to to meet the requirements of 35 U.S.C. 112, first or second paragraphs. Without pointing out specific connections or component content that one of ordinary skill in the art would not be able to provide or perform, the rejection is merely an assertion of a legal conclusion without evidence or sound scientific reasoning that would support such an accusation. If the Examiner feels there is some specific failing in the enablement of the specification, the basis for that opinion must be specifically supported by evidence on the record. This has not been done, and therefore the rejection is inadequate as a matter of law. *In re Strahilevitz*, specifically requires that:

> "A threshold issue is whether the PTO met its burden of proof in calling into question the enablement of appellant's disclosure. This burden required that the PTO advance acceptable reasoning inconsistent with enablement."

The rejection of record has failed to meet even this threshold burden of proof. The mere allegation of lack of enablement because of the use of general descriptive terms fails to establish a *prima facie* case on this issue. The fact that Applicant has established that every element in the combination is generically known as a component for video gaming equipment, that the ordinarily skilled artisan is capable of designing each element with the appropriate informational content, that the individual components of information content are known in the art, and that the connection an interaction of these components is within the skill of the artisan, Applicant has *prima facie* established enablement and the burden on the PTO for overcoming that established enablement requires sound reasoning and facts, not the mere allegation of a legal conclusion without supporting evidence.

The specification is asserted to describe several embodiments, but is asserted to not clearly define a single best mode of the invention. 35 U.S.C. 112, first paragraph require that applicants describe the best mode of practicing the invention known at the time that the application was filed. The specification does include a description that attorney for applicant confirmed was the best mode of practicing the invention. That regulation does not require an applicant to flag the best mode. Neither by specific language or case law must the specification specifically identify the best mode. This fact is clear on the face of the regulation requiring that:

> "The specification...shall set forth the best mode contemplated by the inventor off carrying out his invention."

Applicant has included an enabling description for practicing the best mode of the invention contemplated by the inventor at the time of filing the application. That description meets the requirements of 35 U.S.C. 112, first paragraph. Applicant is required to do no more according to the statutes. This rejection is legally in error and must be withdrawn.

The rejection also asserts that the specification fails to define the "universal" quality of the disclosed invention. This rejection is also specifically traversed. Applicant does specifically describe and enable a universal game controller. This is clearly pointed out in the original specification as filed. Although a complete review of the specification would be preferred, Applicant will specifically point out page 9, lines 5-13; page 7, lines 7-13; and page 8, lines 6-18. The meaning of that disclosure is that by providing the universal game controller that does not need to have its hardware or software redesigned to conform to various gaming systems via I/O interfaces. The software or hardware can be designed once and then can be used to control various gaming systems (Page 8, lines 13-18). This is its universality. Once the peripheral control system has been designed and implemented (as hardware and software), only game rules and game specific controls (e.g., rules and payout tables for regular draw poker, deuces wild poker, jokers wild poker, etc.) must be created and added to the video gaming equipment. All peripherals (e.g., coin changers, coin counters, etc.) are already controlled by the universal board. Only specific game rules need to be overlaid by provision of a motherboard with game specific rules. The game controller is therefore universal because, by providing the appropriate pinning to the physical apparatus, and providing a set of game specific rules, the game controller may be

universally used with any physical apparatus and any set off game rules that can be performed on the physical apparatus.

This objection is clearly in error and must be withdrawn.

RESPONSE TO THE REJECTIONS

Rejections Under 35 U.S.C. 112

Claim 18 was rejected as not being enabled by the specification and as not being shown by a best mode of practicing the invention. As noted above, these rejections are legally insufficient as a matter of law.

Even though the request to differentiate the claimed subject matter from the prior art (stated in this rejection) is more appropriate to issues under 35 U.S.C. 103 and 35 U.S.C. 103(a), Applicant will emphasize and explain at least some of the specific differences recited in claim 18:

> An interface adapter configured to operatively couple an interface assembly to a communication port operatively coupled to a **computerized video wagering game controller comprising nonvolatile storage with instructions stored thereon, the instructions when executed operable to cause the computer to execute a video wagering game controlled via the user interface assembly**.

Applicant asserts that the prior art does not show the totality of the highlighted portions of the claim. The use of game controls (by the peripherals in the interface/controller assembly) executed by the computer (which is distinct from the interface/controller assembly) is novel and unobvious. Even the general terms used clearly distinguish from the prior art.

The basis of the rejection appears to be an implication that the claims are "too broad" even though they have not been shown to read on the prior art. Applicant believes that the generic invention and pioneering invention described in the claims is entitled to sufficiently broad coverage to protect the true scope of the invention.

The Rejection of Claims 1-21 Under 35 U.S.C. 103(a)

Claims 1-21 have been rejected under 35 U.S.C. 103(a) as unpatentable over Acres (U.S. Patent No. 5,752,882) in view of Arcade Machine Retrofit (10/20/1996, www.cygnus.uwa.edu.aujaycole/jaw/arcade.htlm, hereinafter referred to as "Arcade"). The rejection asserts that Acres shows:

1) controlling a variety of gaming devices produced by different manufacturers through a common interface unit;
2) linking gaming machines to a common controller; and
3) employing PCs as central controllers.

It is then asserted that Arcade shows retrofitting of video arcade games. It was then asserted that it was obvious to one of ordinary skill in the art to retrofit the apparatus of Acres as described by Arcade, therefore rendering the invention obvious to one of ordinary skill in the art.

It is first to be noted that the art cited against the present invention is not relevant to the actual field of the invention. The present invention as claimed and as originally claimed recites computerized wagering game apparatus, while the reference art used in the rejection is uniformly directed towards arcade games. This is non-analogous art and does not form a good basis for even beginning an analysis of the present invention. Additionally, there is substantial information recited in the claims that also clearly differentiates the invention and the field of the invention from the prior art. Among such limitations are (from claim 1):

a) computerized wagering game status information and
b) symbol elements that change with the play of the wagering game.

There is absolutely no disclosure in either of the references used in the rejection with regard to these types of limitations in the claims. The rejection is fatally deficient with respect to providing disclosure of underlying limitations and elements of the claimed invention.

The rejection fails to appreciate the underlying concept of the invention recited in the claims. This failure will be analyzed with respect to claim 1, with that claim reproduced below, and salient deficiencies in the prior art used in the rejection highlighted in the claim.

A computerized **wagering game apparatus**, comprising:
a computerized game controller operable to control a computerized wagering game;
a video display device providing a visual representation of a signal provided by the

computerized game controller such that the **video display device displays** at least one visual image selected from the group consisting of

c) computerized **wagering game status information** and

d) **symbol elements that change with the play of the wagering game;**

a **communication port communicatively coupled to the computerized game controller;**

a **interface assembly comprising one or more user interface devices;** and

an I/O interface configured to communicatively couple the interface assembly to the communication port.

Each of these features in wagering apparatus is absent from the disclosure of the references cited in the rejection. Additionally, the concept of executing peripheral controls in the universal controller from a separate computer has not been disclosed in the art cited in the rejection.

Additionally, the recited element of the "interface assembly comprising one or more user interface devices" is not shown in the art. Even though the gaming apparatus of Acres has user interface devices, these are not located within an interface assembly, but is supported on the computer motherboard. This is consistent with the background of the prior art. Neither reference nor the combination of references even hints at this type of modification of the prior art video wagering gaming apparatus.

Acres controls local computers (*for example, within a casino) from a central computer. The central computer sends signals to the local computers to adjust any functions that a human controller intends to adjust. This is in stark contrast to the use in the present invention of supplemental hardware, a physical device as opposed to a distal signal, to alter play activities. There is no obvious connection between the distal, computer-based control system of Acres and the locally implanted, hardware modifications recited in the practice of the present invention. Acres focuses on remote configuration (see column 6, lines 35 3-8) while the present invention recites only direct local control by addition of a device. There is almost no nexus between the teachings of Acres and the claimed invention. In fact, the majority of hardware discussed by

Acres relative to the implementation of that invention is located outside the gaming apparatus. Note for example, column 10, lines 17-43 for the discrete machine interface, which is located o utside the gaming apparatus.

Additionally, the teachings in Arcade teach nothing reasonable to the practice of the present invention. A brief review of Arcade shows that it is a worthless reference with regard to the recited practice of the invention.

The first step taught by Arcade is "Rip out everything from the box!" (emphasis natural). The second step in Arcade is "Rewire the buttons." The third step is "Chop up a keyboard." The entire procedure and disclosure is to replace one existing play system with another complete play system. There is no concept of providing a universal peripheral wagering game system that can then be driven by replaceable wagering game rules provided as a distinct component.

Note the distinct difference of this process (the only retrofitting process cited in the art used in the rejection) and the process recited in claim 9:

> "...a) **removing an original special-purpose computerized game controller** used to control a computerized wagering game from the apparatus, the original computerized game controller designed to and capable of working exclusively with a particular computerized wagering game apparatus;
>
> b) **inserting a universal computerized game controller** operable to control a video wagering game that can be played on the video wagering game apparatus **and an I/O interface that operatively couples the universal computerized game controller to user interface devices of the wagering game apparatus;**..."

Rather than ripping out the entire box (the quote from Arcade), the game controller is removed, and the wagering game elements remain in the system and are then driven by the inserted universal game device. These steps are not shown by Acres in view of Arcade.

Claim 10 similarly requires that the "...display device displays at least one visual image selected from the group consisting of a) computerized wagering game status information and b) symbol elements that change with the play of the wagering game." This is not shown by either reference or the combination of references.

Claim 18 requires a combination of specific elements that are not suggested by the combination of Acres in view of Arcade. Specifically claim 18 recites:

> 18. An **interface adapter configured to operatively couple an interface assembly to a communication port operatively coupled to a computerized video wagering game controller comprising nonvolatile storage with instructions stored thereon**, the instructions when executed operable to cause the computer to execute a video wagering game controlled via the user interface assembly.

The highlighted limitations are clear recitations of elements and their function in the practice of the invention. This combination of elements and their functions are not shown in the combination of Acres in view of Arcade which has been used to reject the claims. In particular, there is no interface adapter operatively coupling an interface assembly to a communication port coupled to a **computerized video wagering game controller comprising volatile storage with instructions stored therein**. These highlighted features and functions are clearly absent from the combination of references used in the rejection.

New claims 22-25 recite an aspect of the invention emphasizing these points and also clearly distinguish from the two references cited in the rejection.

CONCLUSION

All rejections have been shown to be in error. All rejections should be withdrawn and all claims allowed.

Respectfully submitted,

Mark L. Yoseloff
By his Representatives,
MARK A. LITMAN & ASSOCIATES, P.A.
YORK BUSINESS CENTER, SUITE 205
3209 West 76th Street
Edina, MN 55435
(952) 832.9090

Date By

AMENDMENT AND RESPONSE

Applicant: Mark L. Yoseloff. Docket No.: 307.026US1 PA0368.ap.US
Serial No.: 09/405,921 Examiner: S. Ashburn
Filed September 24, 1999 Group Art Unit: 3713
Title: VIDEO GAMING APPARATUS FOR WAGERING WITH UNIVERSAL COMPUTERIZED CONTROLLER AND I/O INTERFACE FOR UNIQUE ARCHITECTURE

Mark A. Litman

Reg. No. 26,390

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Assistant Commissioner of Patents, Washington, D.C. 20231 on **March 31, 2001**.

Name Mark A. Litman Signature